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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,806	05/25/2006	David Jay Duffield	PU030224	8853

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EXAMINER

CHOKSHI, PINKAL R

ART UNIT	PAPER NUMBER
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2425

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03/11/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/580,806	Applicant(s) DUFFIELD, DAVID JAY	
	Examiner Pinkal R. Chokshi	Art Unit 2425	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8 and 10-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8 and 10-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. In view of the Appeal Brief filed on 12/31/2009, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Brian T. Pendleton/

Supervisory Patent Examiner, Art Unit 2425.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a) because they fail to show details for reference numbers as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown

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in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1, 2, 4-8, and 10-13** are rejected under 35 U.S.C. 103(a) as being unpatentable over US PG Pub 2002/0170053 to Peterka et al (hereafter referenced as Peterka) in view of US Patent 6,697,489 to Candelore et al (hereafter referenced as Candelore) and US Patent 5,966,386 to Maegawa (hereafter referenced as Maegawa).

Regarding **claim 1**, “an access device” reads on the client computer that receives the free preview of a program before deciding to order the program (abstract) disclosed by Peterka and represented in Fig. 1 (element 112).

As to “device comprising: means for communicating an impulse purchase selection to a service provider” Peterka discloses (§§0047, §0090) that the server system provides a free preview of the initial portion of the program, where after watching the preview, user decides to purchase the program content (IPPV) as represented in Fig. 5 (element 512).

As to “means for receiving an authorization key transmitted by the service provider in response to the impulse purchase selection” Peterka discloses (§§0086, §0090, §§0095-§0101, claim 10) that the key is provided by a server in response to the purchase request received from client computer as represented in Fig. 5.

As to “means for receiving a program associated with the impulse purchase selection” Peterka discloses (§§0090, §0132) that the requested program content is distributed to the client computer as represented in Fig. 5 (element 520) and Fig. 16B.

As to “means for processing the received program using the authorization key” Peterka discloses (§0090) that the user is provided with the key that is used to decrypt the encrypted programming content transmitted to client computer as represented in Fig. 6 (element 616).

As to “wherein the access device transmits the billing record to the service provider” Peterka discloses (§0047) that the client computer stores a record of the impulse PPV and transmits the billing record to the service provider at a later time.

Peterka meets all the limitations of the claim except “communicating to a service provider using an out of band frequency which is different than content providing frequencies.” However, Candelore discloses (col.8, lines 37-48) that the set top unit uses out-of-band frequency transmitter, which is different than the content received, to deliver request to head-end for IPPV program as represented in Fig. 8 (element 721). Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention to modify Peterka’s system by using out-of-band frequency to communicate between STB and head-end as taught by Candelore in order to separate two different kinds of data from the stream.

Combination of Peterka and Candelore meets all the limitations of the claim except “generating a billing record in response to the receipt of the authorization key.” However, Maegawa discloses (col.9, lines 19-46) that the client device receives the requested data w/ the encryption key from the service

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provider, where the client device adds a digital signature to the order data and payment instruction data, encrypts it by the received encryption key, and transmits it to the biller of the service provider to perform the billing processing based on the above mentioned order as represented in Fig. 9. Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention to modify Peterka and Candelore's systems by generating billing record in response to the receipt of authorization key as taught by Maegawa in order to charge user only when the user selects to watch the entire PPV program.

Regarding **claim 2**, "an access device comprising: means for indicating a desired impulse purchase selection" reads on the client computer that receives the free preview of a program before deciding to order the program (abstract) disclosed by Peterka and represented in Fig. 1 (element 112). Peterka further discloses (§§0047, §0090) that the server system provides a free preview of the initial portion of the program, where after watching the preview, user decides to purchase the program content (IPPV) as represented in Fig. 5 (element 512).

As to "means for communicating the desired impulse purchase selection to a service provider" Peterka discloses (§§0047, §0090) that the server system provides a free preview of the initial portion of the program, where after watching the preview, user decides to purchase the program content (IPPV) as represented in Fig. 5 (element 512).

As to "means for receiving an authorization key transmitted to the access device, and specific to, the desired impulse purchase selection" Peterka discloses (§§0086, §§0090, §§0095-§§0101, claim 10) that the key is provided by a server for a requested program in response to the purchase request received from client computer as represented in Fig. 5.

As to "means for receiving the transmission of a desired program associated with the impulse purchase selection" Peterka discloses (§§0090, §§0132) that the requested program content is distributed to the client computer as represented in Fig. 5 (element 520) and Fig. 16B.

As to "means for processing the received program using the authorization key" Peterka discloses (§§0090) that the user is provided with the key that is used to decrypt the encrypted programming content transmitted to client computer as represented in Fig. 6 (element 616).

As to "wherein the access device transmits the billing record to the service provider" Peterka discloses (§§0047) that the client computer stores a record of the impulse PPV and transmits the billing record to the service provider at a later time.

Peterka meets all the limitations of the claim except "communicating to a service provider using an out of band frequency which is different than content providing frequencies." However, Candelore discloses (col.8, lines 37-48) that the set top unit uses out-of-band frequency transmitter, which is different than the content received, to deliver request to head-end for IPPV program as

represented in Fig. 8 (element 721). Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention to modify Peterka's system by using out-of-band frequency to communicate between STB and head-end as taught by Candelore in order to separate two different kinds of data from the stream.

Combination of Peterka and Candelore meets all the limitations of the claim except "generating a billing record in response to the receipt of the authorization key." However, Maegawa discloses (col.9, lines 19-46) that the client device receives the requested data w/ the encryption key from the service provider, where the client device adds a digital signature to the order data and payment instruction data, encrypts it by the received encryption key, and transmits it to the biller of the service provider to perform the billing processing based on the above mentioned order as represented in Fig. 9. Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention to modify Peterka and Candelore's systems by generating billing record in response to the receipt of authorization key as taught by Maegawa in order to charge user only when the user selects to watch the entire PPV program.

Regarding **claim 4**, "the access device wherein the means for receiving the authorization key receives the authorization key via an out of band frequency" Candelore discloses (col.5, lines 40-45; col.8, lines 8-65) that the service provider transmits encrypted service key to the receiving device using out-of-

band channel as represented in Fig. 8 (element 720). In addition, same motivation is used as rejection to claim 2.

Regarding **claim 5**, “the access device wherein the means for communicating the desired impulse purchase utilizes a two way communications interface” Peterka discloses (¶0058) that the consumer-server connection is typically a 2-way connection as represented in Fig. 1 (element 100) and Fig. 2 (element 206).

Regarding **claim 6**, “the access device wherein the billing record transmitted to the service provider is transmitted via the two way communications interface” Maegawa discloses (col.12, lines 54-62) that the biller of the receiving device works together with the biller of a service provider to perform the procedure for billing as represented in Fig. 9. In addition, same motivation is used as rejection to claim 2.

Regarding **claim 7**, “an access device” reads on the client computer that receives the free preview of a program before deciding to order the program (abstract) disclosed by Peterka and represented in Fig. 1 (element 112).

As to “comprising: a tuning and a communications unit for transmitting an impulse purchase message” Peterka discloses (¶0047, ¶0090) that the server system provides a free preview of the initial portion of the program, where after

watching the preview, user decides to purchase the program content (IPPV) as represented in Fig. 5 (element 512). Peterka further discloses (§0036) that the user computer includes a communication system for transmitting/receiving data to/from the service provider as represented in Fig. 2 (element 206).

As to “receiving an authorization key transmitted in response to the transmission of the impulse purchase message and associated with the impulse purchase program” Peterka discloses (§0086, §0090, §0095-§0101, claim 10) that the key is provided by a server in response to the purchase request received from client computer, where the key is associated with the service (IPPV) as represented in Fig. 5.

As to “a controller and decoder unit responsive to the authorization key that formats a digital program into a video display” Peterka discloses (§0090) that the client computer is provided with the key that is used to decrypt the encrypted programming content transmitted to client as represented in Fig. 6 (element 616).

As to “wherein the access device transmits the billing record to the same location as the impulse purchase message” Peterka discloses (§0047) that the client computer stores a record of the impulse PPV and transmits the billing record to the service provider at a later time.

Peterka meets all the limitations of the claim except “communicating to a service provider using an out of band frequency which is different than content providing frequencies.” However, Candelore discloses (col.8, lines 37-48) that the set top unit uses out-of-band frequency transmitter, which is different than the

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content received, to deliver request to head-end for IPPV program as represented in Fig. 8 (element 721). As to “a controller and decoder formats a digital program into a video display” Candelore discloses (col.4, lines 28-30) that the display device displays the processing digital video signals. Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention to modify Peterka’s system by using out-of-band frequency to communicate between STB and head-end as taught by Candelore in order to separate two different kinds of data from the stream.

Combination of Peterka and Candelore meets all the limitations of the claim except “a billing generator which generates a billing record in response to the receipt of the authorization key.” However, Maegawa discloses (col.9, lines 19-46) that the client device receives the requested data w/ the encryption key from the service provider, where the client device adds a digital signature to the order data and payment instruction data, encrypts it by the received encryption key, and transmits it to the biller of the service provider to perform the billing processing based on the above mentioned order as represented in Fig. 9. Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention to modify Peterka and Candelore’s systems by generating billing record in response to the receipt of authorization key as taught by Maegawa in order to charge user only when the user selects to watch the entire PPV program.

Regarding **claim 8**, “a method of providing a secure means for purchasing an impulse purchase program” reads on the method using encryption keys to distribute program content (abstract) disclosed by Peterka and represented in Fig. 1 (element 112).

As to “method comprising the steps of: communicating a message to a service provider means that indicates an impulse purchase selection” Peterka discloses (§§0047, §0090) that the server system provides a free preview of the initial portion of the program, where after watching the preview, user decides to purchase the program content (IPPV) as represented in Fig. 5 (element 512).

As to “receiving, at a receiver, authorization information transmitted in response to the communicated message, and specific to the impulse purchase program” Peterka discloses (§§0086, §0090, §0095-§0101, claim 10) that the key is provided by a server in response to the purchase request received from client computer, where the key is associated with the service (IPPV) as represented in Fig. 5.

As to “receiving, at a receiver, the impulse purchase program” Peterka discloses (§§0090, §0132) that the requested program content is distributed to the client computer as represented in Fig. 5 (element 520) and Fig. 16B.

As to “processing the impulse purchase program in response to the authorization information” Peterka discloses (§0090) that the user is provided with the key that is used to decrypt the encrypted programming content transmitted to client computer as represented in Fig. 6 (element 616).

As to “transmitting the billing record from the receiver to the service provider” Peterka discloses (¶0047) that the client computer stores a record of the impulse PPV and transmits the billing record to the service provider at a later time.

Peterka meets all the limitations of the claim except “using an out of band frequency which is different than content providing frequency.” However, Candelore discloses (col.8, lines 37-48) that the set top unit uses out-of-band frequency transmitter, which is different than the content received, to deliver request to head-end for IPPV program as represented in Fig. 8 (element 721). Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention to modify Peterka’s system by using out-of-band frequency to communicate between STB and head-end as taught by Candelore in order to separate two different kinds of data from the stream.

Combination of Peterka and Candelore meets all the limitations of the claim except “generating a billing record at the receiver in response to the receipt of the authorization key.” However, Maegawa discloses (col.9, lines 19-46) that the client device receives the requested data w/ the encryption key from the service provider, where the client device adds a digital signature to the order data and payment instruction data, encrypts it by the received encryption key, and transmits it to the biller of the service provider to perform the billing processing based on the above mentioned order as represented in Fig. 9. Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the

invention to modify Peterka and Candelore's systems by generating billing record in response to the receipt of authorization key as taught by Maegawa in order to charge user only when the user selects to watch the entire PPV program.

Regarding **claim 10**, "the method wherein the receiving step comprises receiving the authorization via an out of band frequency" Candelore discloses (col.5, lines 40-45; col.8, lines 8-65) that the service provider transmits encrypted service key to the receiving device using out-of-band channel as represented in Fig. 8 (element 720). In addition, same motivation is used as rejection to claim 8.

Regarding **claim 11**, "the method wherein the communicating step comprises communicating the message via a two way communications interface" Peterka discloses (§10058) that the consumer-server connection is typically a 2-way connection as represented in Fig. 1 (element 100) and Fig. 2 (element 206).

Regarding **claim 12**, "the method wherein the billing record is transmitted to the service provider via the two way communications interface" Maegawa discloses (col.12, lines 54-62) that the biller of the receiving device works together with the biller of a service provider to perform the procedure for billing as represented in Fig. 9. In addition, same motivation is used as rejection to claim 8.

Regarding **claim 13**, “a method of providing a secure means for purchasing an impulse purchase program” reads on the method using encryption keys to distribute program content (abstract) disclosed by Peterka and represented in Fig. 1 (element 112).

As to “method comprising the steps of: selecting the desired impulse purchase program” Peterka discloses (§0047, §0090) that the server system provides a free preview of the initial portion of the program, where after watching the preview, user decides to purchase the program content (IPPV) as represented in Fig. 5 (element 512).

As to “communicating the desired impulse purchase program selection to a service provider” Peterka discloses (§0047, §0090) that the client contacts the server to request the programming content.

As to “responding to the communicated impulse purchase program selection by transmitting an authorization code to the access device uniquely associated with the desired impulse purchase program” Peterka discloses (§0086, §0090, §0095-§0101, claim 10) that the key is provided by a server in response to the purchase request received from client computer, where the key is associated with the service (IPPV) as represented in Fig. 5.

As to “transmitting to the access device an impulse purchase program having an entitlement code” Peterka discloses (§0123) that the program content sent to the client computer includes EMM and ECM.

As to “transmitting the billing record from the access device to the service provider” Peterka discloses (§§0047) that the client computer stores a record of the impulse PPV and transmits the billing record to the service provider at a later time.

As to “storing the authorization code associated with the desired impulse purchase program into a security module in the access device” Peterka discloses (§§0086, §§0090, §§0095-§§0101, claim 10) that the key is provided by a server to a client computer in response to the purchase request received from client computer, where the key is associated with the service (IPPV) as represented in Fig. 5. However, Peterka does not explicitly teach that the authorization code is stored into a security module in the access device. However, Candelore discloses (col.8, line 66-col.9, line 6) that the decoder receives the service key for each requested session is stored in the memory of the decoder as represented in Fig. 8 (element 735).

As to “using an out of band frequency which is different than content providing frequency” Candelore discloses (col.8, lines 37-48) that the set top unit uses out-of-band frequency transmitter, which is different than the content received, to deliver request to head-end for IPPV program as represented in Fig. 8 (element 721).

As to “an entitlement code associated with authorization code stored in the security module and decoding the entitlement code” Candelore discloses (col.3, lines 49-61) that the program data received at the device includes EMM and

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ECM. Candelore further discloses (col.4, lines 35-56; col.5, lines 30-34) that the device uses the stored key (authorization code) to match it with the entitlements processed from the received content stream.

As to “comparing the entitlement code to the code stored in the security module to permit viewing of the impulse purchase program” Candelore discloses (col.4, lines 50-56) that when the scrambled program content is received in the device, the access requirement (entitlement code) of the program is compared to the entitlements stored in the device. Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention to modify Peterka’s system by using out-of-band frequency to communicate between STB and head-end and compare the stored key with EMM of the stream as taught by Candelore in order to separate two different kinds of data from the stream and also to allow the viewer to view the correct requested IPPV programs (col.2, lines 54-56).

Combination of Peterka and Candelore meets all the limitations of the claim except “generating a billing record at the access device in response to the receipt of the authorization key.” However, Maegawa discloses (col.9, lines 19-46) that the client device receives the requested data w/ the encryption key from the service provider, where the client device adds a digital signature to the order data and payment instruction data, encrypts it by the received encryption key, and transmits it to the biller of the service provider to perform the billing processing based on the above mentioned order as represented in Fig. 9.

Therefore, it would have been obvious to one of the ordinary skills in the art at

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the time of the invention to modify Peterka and Candelore's systems by generating billing record in response to the receipt of authorization key as taught by Maegawa in order to charge user only when the user selects to watch the entire PPV program.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US PG Pub 2002/0112234 to Bacon
- US PG Pub 2004/0123323 to Russo
- US Patent 6,526,577 to Knudson
- US PG Pub 2004/0078823 to Schlarb

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PINKAL CHOKSHI whose telephone number is (571) 270-3317. The examiner can normally be reached on Monday-Friday 8 - 5 pm (Alt. Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Pendleton can be reached on 571-272-7527. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pinkal Chokshi/
Examiner, Art Unit 2425

/Brian T. Pendleton/
Supervisory Patent Examiner, Art Unit 2425